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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,277	05/27/2005	Yoshio Onoda	086590-0012	2231
20277 7590 08/17/2010 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			EXAMINER WALKER, NED ANDREW	
			ART UNIT 3781	PAPER NUMBER
			MAIL DATE 08/17/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/537,277

**Applicant(s)**

ONODA, YOSHIO

**Examiner**

NED A. WALKER

**Art Unit**

3781

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) 3-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 20-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ ~~Notes of Informal Patent Application~~
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "a top face of said container" and "a portion of said seal face part" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show "a portion of said seal face part contacts said container above the seam part and below the top face" as described in Claim 1. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d).

2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter (37 CFR 1.75(d)(1) and MPEP §608.01(o)) with respect to the Amendment filed May 19<sup>th</sup>, 2010. Correction of the following is required:

Amended Claim 1 comprises the limitation "a portion of said seal face part contacts said container *above the seam part and below the top face*" (emphasis added).

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the amendment filed May 19<sup>th</sup>, 2010 comprises the limitation "a portion of said seal face part contacts said container *above the seam part and below the top face*" (emphasis added) as amended in Claim 1. The Examiner could not find support for this limitation in the originally filed disclosure.

Claims 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the amendment filed May 19<sup>th</sup>, 2010 comprises the limitation "a portion of said seal face part contacts said container *above the seam part and below the top face*" (emphasis added) as amended in Claim 1.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**7. Claims 1, 20, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Roth (US Pat. No. 2,266,270).**

Roth discloses a cap (FIG. 5) disposed around a lid of a container (32) for canned drinks comprising: a seal face part (20) made as a film to expand and contract and covers a top face of said container for canned drinks (FIG. 5); an outer-perimeter part (21) being an elastic material to expand and contract (column 1 lines 48-50) and is disposed on an outer perimeter of said seal face part (FIG. 5), said outer-perimeter part having a cross-sectional composition that is configured and arranged to couple with a recess below a seam part of said container (FIG. 5); wherein an entire top face of said container for canned drinks is covered in a water-tight manner by said seal face by

attaching said outer-perimeter part below a seam part of said container thereby removably and replaceably self-sealing said cap to said container for canned drinks (FIG. 5); wherein a thickness of said seal face part is less than a thickness of said outer-perimeter part (FIG. 5); and wherein a portion of said seal face part contacts said container above the seam part and below the top face (FIG. 5 capable); wherein said outer-perimeter part has a cross-sectional compositional shape that is circular (FIG. 5); wherein said seal face part is configured and arranged to deform to a bottom of said container for canned drinks to permit stacking of said container (FIG. 5 capable).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. **Claims 2 and 21 are rejected under 35 U.S.C. 103(a) as being obvious over Roth (US Pat. No. 2,266,270).**

Roth, as applied to claim 1 above, teaches substantially all the limitations of the claim except wherein said seal face part and outer-perimeter part are made of at least one of polystyrene and polypropylene by injection molding as one unit; a thickness of said seal face part is equal to 0.4 mm or less; and a thickness of said outer-perimeter part is equal to 0.5 mm or greater; wherein said seal face part has an expansion ratio of about 1:1.14.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the parts made of at least one of polystyrene and polypropylene by injection molding as one unit, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice (*In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use such thickness ranges, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (*In re Aller*, 105 USPQ 233).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design the seal face part to have an expansion ratio of about 1:1.14, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art (*In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980)).

***Response to Arguments***

11. Applicant's arguments, see amendment filed May 19<sup>th</sup>, 2010, with respect to the rejection of Claims 1, 20, and 22 under 35 USC §102(b) as being anticipated by Roth (US Pat. No. 2,266,270), have been fully considered, but are not persuasive.

Firstly, in response to applicant's argument of alleged support for the newly added Claim subject matter, the Examiner respectfully contends that the Applicant's support is inadequate. Specifically the Applicant states that FIGS. 6b-6d illustrate "once the cap for the canned drink is placed on the can, a portion of the seal face is extended over the portion of the can above the seam part but below the top edge". The Examiner is confused as to how these figures illustrate that the seal face contacts the container above the seam part and below the top face. Instead it was the Examiner's understanding that the seal face part constituted only the top covering or "plateau" portion of the lid and the outer perimeter part comprised the ring and contacting portion that interacted with the can. The Examiner points to FIGS. 1B, 2A, and 3A which identify the seal face 11 as the top flat part and the outer perimeter 12 part consisting of the ring that extends downward from it and has the coupling portion for engaging the can recess. Applicant's Specification, page 9 line 25 - page 10 line 1, states "the cap for canned drinks 10 is stably attached to the container 20 by the outer-perimeter 12 engaging with the recess 22 formed below the seam 21, by the elasticity of the outer-perimeter 12 and by the latching action provided by the recess 22. The cap being attached in this way, the top face of the container for canned drinks 20 can be covered water-tight by making the surface of the seal face part 11 abut the upper end of the seam 21 of the container for canned drinks 20". No mention is made with respect to the seal face part contacting the can below the top face.



In response to applicant's arguments, the recitation "a lid of a container for canned drinks" has not been given patentable weight because the recitation occurs in the preamble. Therefore, all subsequent structure given to the container and/or lid has been treated similarly along with any relationships such structure may have with seal face part or outer perimeter part. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to applicant's argument that Roth does not anticipate "a portion of said seal face part contacts said container above the seam part and below the top face" and "said seal face part is configured and arranged to deform to a bottom of said container for canned drinks to permit stacking of said container", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case the crowned disk is capable of attaching to a container design according to the claims that is capable of achieving the aforementioned relationships.

For these reasons, the rejection of claims 1-4 under 35 USC §102(b), as being anticipated by Roth (US Pat. No. 2,266,270), is hereby affirmed.

***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NED A. WALKER whose telephone number is (571)270-3545. The examiner can normally be reached on Monday - Friday 7:30 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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